

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Ludovic POUPINET et al.

Group Art Unit: 1794

Application No.: 10/535,338

Examiner: G. HIGGINS

Filed: October 19, 2005

Docket No.: 123936

For: OPTICAL RECORDING MEDIUM BASED ON A TELLURIUM AND ZINC ALLOY

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are directed to the new points of argument raised in the Examiner's Answer dated February 20, 2009.

I. The Examiner's Reasoning In The Examiner's Answer Continues To Be Based On Impermissible Hindsight In View Of Appellants' Specification

In the Examiner's Answer, the Examiner alleged on page 8 that because Takahashi allegedly describes that the subset of preferred metals may be "used individually or in combination", Takahashi therefore denotes bimetallic alloys as in the "combination" of metals. Furthermore, in the Examiner's Answer on page 8, the Examiner stated that "[h]aving established this [i.e., that Takahashi allegedly describes a bimetallic alloy], the Examiner now turns his attention to selection of zinc and tellurium in the bimetallic alloy." Appellants respectfully submit that the Examiner's own analysis in the Examiner's Answer further

demonstrates how his reasoning is based on impermissible hindsight in view of Appellants' specification.

As previously described on pages 8-9 of the Appeal Brief, Appellants submit that in order for one having ordinary skill in the art to have arrived at the subject matter recited in the present claims, such a person would have been required to perform numerous selections without any indication in Takahashi to have done so. Specifically, one would had to have first picked a bimetal alloy (as opposed to a single component metal, a three component alloy, a four component alloy, a five component alloy, a six component alloy or a seven component alloy) from Takahashi's list of preferred metals, then one would have had to have selected Zn and Te as the two components for the bimetal alloy, and then still further would had to have chosen Zn and Te to be present in the amounts of 60-70 atomic % Zn to 30-40 atomic % Te.

However, the Examiner's own arguments in the Examiner's Answer merely embody an improper hindsight analysis. The phrase "[h]aving established this, the Examiner turns his attention ..." demonstrates this. The Examiner presumes that merely because bimetallic alloys might be possible in Takahashi, one of ordinary skill in the art would have selected only bimetallic alloys for investigation. There is no direction for this selection in Takahashi, and the Examiner's attempted narrowing of Takahashi's disclosure to only bimetallic alloys is without merit and could have only been done via hindsight.

Furthermore, Appellants are not disputing that Takahashi describes a list of seven metals to be used in an optical recording layer. Appellants are disputing the Examiner's reasoning that because Takahashi merely describes a list of metals, one having ordinary skill in the art would have been motivated to have performed the multiple steps for selecting (1) a bimetallic alloy, (2) Zn and Te as the components for the bimetallic alloy and (3) the amount of Zn and Te to be present in the amounts of 60-70 atomic % Zn and 30-40 atomic % Te.

These multiple selections are in no way indicated nor disclosed in Takahashi, and thus are clearly based solely on the Examiner's selective hindsight "picking and choosing" from the Takahashi disclosure. How one having ordinary skill in the art would have arrived at the optical recording layer recited in the present claims from Takahashi requires one to have possessed advanced knowledge of Appellants' specification in order to have narrowed the overly broad disclosure of Takahashi to Appellants' present claims. Such a method of reasoning, including the Examiner's, is clearly based on impermissible hindsight in view of Appellants' specification.

II. The Examiner Continues To Misapply The Standard For Determining Obvious To Try

A. The Examiner First Raised The Possibility Of Applying An Obvious To Try Standard

In the Examiner's Answer on page 9, the Examiner alleges that Appellants first raised the obvious to try standard in the Amendment After Final Rejection filed on November 21, 2008.

While the Final Rejection does not explicitly indicate an "obvious to try" standard, Appellants direct the Board's attention to the following statement made by the Examiner in the Final Rejection issued on July 22, 2008 ("Final Rejection") "[i]t is well-known in the field of optical recording media to experimentally vary the percentages of metals contained with the alloy of a recording layer." See Final Rejection, page 3 (emphasis added). The phrase "experimentally vary" indicates an obvious to try analysis, which Appellants have addressed.

B. The Examiner Focus On The "Finite" Portion Of The Obvious To Try Analysis Is Incorrect

Regardless, the Examiner's obvious to try analysis is not correct. In the Examiner's Answer at pages 9-10, the Examiner alleges that Appellants' assertion of an obvious to try standard is allegedly unclear because Appellants allegedly pointed out a "finite number of possibilities" and the Examiner allegedly demonstrated that one having ordinary skill can

identify the total number of possibilities. Appellants respectfully submit that the Examiner continues to misapply the obvious to try standard.

The Examiner continues to focus on the "finite" portion of the obvious to try analysis. However, an obvious to try analysis requires (1) a finite number of (2) identified, (3) predictable solutions. See MPEP §2143E.

Appellants do not dispute that the alleged preferred metals of Takahashi may be combined in a total of 127 possible combinations and thus that 127 is a "finite" number. Appellants take issue with the Examiner's allegation that it would have been obvious to one of ordinary skill in the art to have selected the Zn-Te bimetallic alloy from among the other 126 possible combinations. As described in the below cases, the Examiner's reasoning and conclusion of obviousness is improper.

As described in *In re O'Farrell*, 7 USPQ 2d. 1673 (CCPA 1988), the Federal Circuit held that an obvious to try standard requires an "indication in the prior art as to which parameters were critical or which choices were likely to be successful" and further held that mere "general guidance" from the prior art is not sufficient. See *In re O'Farrell* at 1681. As previously described, Takahashi merely describes a list of seven metals and thus fails to indicate which parameters for selecting these metals would be critical or which choices could be successful to have manufactured the recording layer of the present claims.

In *Pfizer Inc. v. Apotex*, 480 F.3d 1350 (CCPA 2007), the Federal Circuit held that the prior art must provide "ample motivation" for one of ordinary skill in the art to have narrowed the possibilities for a compound. See *Pfizer Inc.* at 1363 and 1367. In other words, the art must provide some reason for one to select a particular path from a general teaching. A general teaching alone to vary all parameters or try each possible choice is insufficient to direct one to an identified, predictable solution. In this case, analogous to *Pfizer*, to support the obviousness analysis, Takahashi must have provided one of ordinary skill in the art with

"ample motivation" to have narrowed the 127 possible alloy combinations and thus have arrived at the combination recited in the present claims. Takahashi's disclosure of the seven "preferred metals" is no more than a general disclosure of the metals that could have been used in the active layer and thus would not have provided one with the necessary direction to have formed the alloy in the amount recited in claim 12.

Furthermore, in the Examiner's Answer, the Examiner alleges that it would have been obvious to one having ordinary skill in the art to have used "any of the identifiable 127 possible recording layers with a reasonable expectation of success in making a heat mode recording layer." See page 10 of the Examiner Answer. Appellants respectfully disagree.

In *Medichem v. Rolabo*, 437 F.3d, 1157 (Fed. Cir. 2006), the Federal Circuit held that "to have a reasonable expectation of success, one must be motivated to do more than merely vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result" where the prior art provided (1) no indication as to which parameters were critical or (2) no direction as to which of many possible choices would have been successful. See *Medichem, S.A. v. Rolabo, S.L.*, at 1165.

As demonstrated by the *Medichem* decision, the Examiner's conclusion is inappropriate because Takahashi (as the cited reference) does not provide any indication as to which parameters (i.e., number of material in the alloy, type of materials in the alloy and concentration of these material in the alloy) would have been critical or provide any direction for one to have selected the claimed Zn-Te combination over the remaining 126 possible combinations. The lack of direction provided by Takahashi further demonstrates that Takahashi does not provide a reason or rationale to have picked a bimetal alloy (as opposed to a single component metal, a three component alloy, a four component alloy, a five component alloy, a six component alloy or a seven component alloy) from Takahashi's list of preferred metals, then to have further picked Zn and Te as the two components for the bimetallic alloy,

and to then still further have picked Zn and Te to be present in the amounts of 60-70 atomic % Zn and 30-40 atomic % Te. In view of the lack of "ample motivation" provided by Takahashi, the Examiner's reasoning is improper and based only upon impermissible hindsight in view of Appellants' specification.

As such, Appellants respectfully submit that Takahashi does not provide a basis to conclude obviousness.

C. Conclusion

In view of the foregoing arguments, the 35 U.S.C. §103(a) rejection maintained by the Examiner is improper and should be reversed.

III. Conclusion

For all the reasons stated in the Brief on Appeal, as well as the additional reasons set forth above, Appellants respectfully request this honorable Board to reverse the rejections of claims 12-16 and 20-22.

Respectfully submitted,



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